

Remarks

Claims 34, 40-48 and 51 are pending in the above identified application. In the Office Action, the Examiner indicated that all of the pending claims are allowed and that the application is in condition for allowance except for formal matters specified in the Office Action. The present amendments, more fully described in the remarks below, are intended to completely address the Examiner's objections to these formal matters.

The Office Action states "[t]he Brief description of the drawings section needs to be amended to reflect the changes to the drawings as of the amended drawings of 11/29/10." Accordingly, the Description of the Figures section of the substitute specification submitted herewith has been amended to reflect the previous changes to the drawings as of the amended drawings of November 29, 2010. More specifically, an amended set of drawings deleting Figures 4, 5, 8, and 9 in their entirety were submitted by the Applicant on June 1, 2010 and subsequently entered by the Examiner. Therefore, the present amendment to the Description of the Figures section of the Specification (as incorporated into the substitute specification submitted herewith) deletes the description of previously deleted Figures 4, 5, 8, and 9 and also revises the numbering of the remaining figures in order to be consistent with the set of figures presently in the application.

The substitute specification submitted herewith also has been amended throughout to remove language making reference to figures that were previously deleted (i.e., Figures 4, 5, 8, and 9) and/or to correct the number of a figure referred to in the specification if the previous deletion (and renumbering) of figures necessitated such a correction.

The Examiner indicated in the Office Action that the benefit claim filed on 6/1/11 (to 10/849615) was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). Upon further consideration, the Applicant has decided not to claim the benefit of priority to U.S. application 10/849615. Therefore, the Applicant has incorporated an amendment to the first paragraph of page 1 of the substitute specification submitted herewith, to indicate that the present application is a 35 U.S.C. § 371 U.S. national-phase application of International Application No. PCT/US2004/015786, which claims priority to U.S. Provisional Application Serial Number 60/471,958 filed May 20, 2003 (and not U.S. Application 10/849615).

In the Office Action, the Examiner also objected to the Declaration and Power of Attorney submitted with the initial filing of the instant application on the grounds that it was "defective

because the first page indicates that the instant application was filed as 10/849615.” The Examiner concluded that the statement on the first page of Declaration and Power of Attorney is “erroneous” because “[t]he instant application was filed as a 371 of PCT/US2004/015786.” In response to the Examiner’s objection, the Applicant has submitted currently herewith a supplemental Declaration in compliance with 37 CFR 1.67(a) along with the surcharge fee under 37 CFR 1.16(f) for filing a declaration on a date later than the filing date of the application. The supplemental Declaration submitted concurrently herewith correctly indicates that the instant application was filed as a 35 U.S.C. § 371 national phase application of PCT/US2004/015786.

Lastly, in the Office Action, the Examiner indicated that the rejection of claims 34, 48, and 51 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of previously co-pending Application No. 11/572634 (now U.S. Patent No. 7,740,847) were withdrawn in view of the terminal disclaimer filed on June 1, 2011. Applicants certainly agree with the rejection being withdrawn on the basis of the terminal disclaimer filed by the Applicant in accordance with the provisions of 37 CFR 1.321(c). Nonetheless, the Applicant would like to make the Examiner aware that prior to the submission of the terminal disclaimer filed on June 1, 2011, the patent which formed the basis for the rejection (the ‘847 patent) was assigned to another party. More specifically, on January 7, 2011, Applied Molecular Evolution (AME), Inc., a wholly-owned subsidiary of Eli Lilly and Company, assigned to Mentrik Biotech, LLC, AME’s entire right, title and interest in and to the ‘847 patent. However, because the term "commonly owned" is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person(s) or organization(s)/business entity(ies) at the time the claimed invention was made, Applicants submit that the previously filed terminal disclaimer in compliance with 37 C.F.R. 1.321(c) obviates issues of judicially created double patenting in the present patent application. For instance, MPEP 804.02(II) states:

Where the subject matter of the reference and the claimed invention were commonly owned at the time the invention was made, such terminal disclaimers must include a provision that the patent shall be unenforceable if it ceases to be commonly owned with the other application or patent.

Here again, Applicants submit that the ‘847 patent was, at the time the claimed invention of the instant application was made, commonly owned by Applied Molecular Evolution, Inc. Because the terminal disclaimer filed in the instant application includes, in accordance with 37 C.F.R.

1.321(c), *inter alia*, a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, and because nothing in 37 C.F.R. 1.321(c) suggests that the application claiming an invention rejected on the grounds of nonstatutory obviousness-type double patenting must be commonly owned with the application or patent which formed the basis for the rejection at the time of the filing of the terminal disclaimer, the Applicants submit that the rejection of claims 34, 48, and 51 on the ground of nonstatutory obviousness-type double patenting was properly withdrawn by the Examiner.

In light of the amendments requested herein, the Applicant respectfully asserts that the instant application is now in condition for allowance and kindly requests passage of the application to issue. The Applicant submits that the substitute specification enclosed herewith includes no new matter.

The Applicant does not believe that any additional fees are incurred; however, any additional fees associated with this amendment may be charged to Eli Lilly Deposit Account number: 05-0840.

Respectfully submitted,

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